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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,170	04/03/2000	Richard A. Mazur	47171-00267	4989

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JENKENS & GILCHRIST, P.C.
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CHICAGO, IL 60606

EXAMINER

BEAUCHAINE, MARK J

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/541,170

Applicant(s)

MAZUR ET AL.

Examiner

Mark J. Beauchaine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 164-311 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 164-311 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 33. 6) ☐ Other: _____

DETAILED ACTION

Inventorship

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Information Disclosure Statement

The Information Disclosure Statement (IDS) dated 30 June 2003 (Paper Number 33) was reviewed by the Examiner and forwarded to the Applicant via Notice of Allowability dated 22 August 2003. The number of items of prior art cited by said IDS was expansive. Specifically, the Form PTO-1449 consisted of 10 pages and cited 260 separate items of prior art. The Examiner was unable to locate 77 of said cited items of prior art. (An updated copy of said Form PTO-1449 is attached to the instant Office action.) Based on a review of the prior art available to the Examiner, the above-mentioned Notice of Allowability was issued. Subsequent to the issuance of said Notice of Allowability, the Examiner was able to obtain 73 of the missing items of prior art from

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various sources. The following 4 items remain missing, and thus, have not been considered:

Item I35 European Patent Publication Number EPA0342647,

Item J118 AFB Currency Recognition System (1982),

Item J119 Banking Machine Digest, and

Item J120 Billcon D-202, D204 Operator's Manual.

The Applicant is invited to either submit said missing items for consideration, or to make reference to said items as they may be indexed in the Cummins-Allison Library located at the USPTO at PK5-5T11.

Of the newly found 73 items, the Examiner considers the following three items to be of particular relevance to the Applicant's claimed invention because of their non-piece count halting feature:

Item I43 Japanese Patent Publication Number 54-71673 published 8 June 1979,

Item I44 Japanese Patent Publication Number 54-71674 published 8 June 1979, and

Item I53 Japanese Patent Publication Number 61-14557 published 19 April 1986.

Based upon the above-mentioned patent publications, the Withdrawal from Issue was forwarded to the Applicant on 31 October 2003. The resulting rejections under 35 USC 103 follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 164-205, 207, 208, 250, 251, 253-260, 262, 263, 280, 281, 283-292, 294-297 and 300-311 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application Publication Number 54-71673 published 8 June 1979 (hereinafter the '673 publication). The currency processing device of the '673 publication incorporates a loading unit 2, collection platform 23 and discharge slot (page 8, line 1) that read on the Applicant's input receptacle and two output receptacles, respectively. Furthermore, the '673 publication discloses an operation of the device such that notes "are extracted sequentially one at a time [to be] counted," and the denomination of the notes are identified (page 2, lines 1 plus). Still further, the '673 publication discloses the step of "suspension or cancellation of a count operation if there is a misidentification of a denomination" (page 1, lines 8 plus).

The '673 publication fails to specifically refer to a second output receptacle. However, the operation of the above-mentioned discharge slot is analogous to the operation of the Applicant's second output receptacle. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate an output receptacle adjacent to said discharge slot of the '673 publication to provide an effective means of retaining and accumulating discharged notes.

Claims 206, 252, 261, 282, 293 and 298 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '673 publication as applied to claims 204, 250, 259, 280, 291 and 296, respectively, above, and further in view of Patent Number 4,487,306 by Nao et al (hereinafter the Nao patent). The '673 publication fails to disclose a currency processing device capable of processing bills of different sizes. However, currency processing devices capable of processing batches of various sized bills are well known in the art. The Nao patent teaches a bill discriminating apparatus that is capable of processing bills of at least two different sizes (column 4, lines 60 plus). Accordingly, it would have obvious to one of ordinary skill in the art at the time of the invention to incorporate the multi-size bill processing feature of the Nao patent into the document processor of the '673 publication to increase the bill discriminating capabilities of the apparatus.

Claims 209-220, 222-249, 264-276, 278, 279 and 299 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '673 publication as explained above, and

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further in view of Patent Number 5,430,664 by Cargill et al (hereinafter the Cargill patent). The '673 publication fails to disclose a processing rate of at least 800 bills a minute. However, document processors having such processing rates are well known in the art. The Cargill patent teaches a document processing apparatus with a "document counting speed of about 1200 documents per minute" (column 11, lines 62 plus). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the processing rate feature of the Cargill patent into the document processor of the '673 publication to enhance the processing efficiency of the processor.

Claims 221 and 277 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '673 publication as explained above, and further in view of the multi-size processing capacity of the Nao patent and the processing rate of the Cargill patent as explained above.

Conclusion

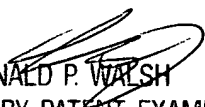
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark J. Beauchaine whose telephone number is (703)308-6336. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

mjb


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600